

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claims 1, 2, 5, 6, 9, 10, 13, 14 and 17 have been amended in response to issues raised in the Office Action. New claims 18-24 are directed to preferred features removed from the amended claims. Claims 1-24 are now pending in this application with claim 9 withdrawn from further consideration pursuant to a finalized restriction requirement.

The specification has been amended to correct the spelling errors noted by the Examiner. The objection to claim 10 has been obviated by deleting "stericly" therefrom.

Claims 2, 8, 10 and 16 have been rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth on pages 3-5 of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

Applicants point out that the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 27 U.S.P.Q.2d 1510 (Fed. Cir. 1993). In fact, a specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement of 35 U.S.C. §112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. See M.P.E.P. §2164.04 and *In re Marzocchi*, 439 F.2d 220, 169 U.S.P.Q. 367

(C.C.P.A. 1971). Here, the Examiner has not satisfied the initial burden of establishing a reason to doubt the statements contained in the specification. The Examiner has only presented conclusions with no factual basis nor cogent reasons to support the position that the specification is non-enabling.

The first paragraph of 35 U.S.C. §112 merely requires that the specification enable one skilled in the art to make and use the invention without undue experimentation. See In re Borkowski, 164 USPQ 642 (CCPA 1970). A detailed description or working example of every possible embodiment falling within a particular claim simply is not (nor has it ever been) a requirement of the first paragraph of 35 U.S.C. §112. In this regard, it is not the function of claims to specifically exclude possible inoperative embodiments. See, *e.g.*, In re Dinh-Nguyen, 181 USPQ 46 (CCPA 1974); Ex parte Janin, 209 USPQ 761 (POBA 1979); and Ex parte Jackson, 217 USPQ 804 (POBA 1982). The breadth of the claims is irrelevant so long as they set forth an invention which is described in the specification such that one skilled in the art can make and use the invention. The Examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually.

With the above principles in mind, applicants respectfully submit that the scope of enablement in the present application is commensurate in scope with the claims when considered as a whole. Those skilled in the art would be able to practice the claimed invention given the information in the disclosure coupled with the level of knowledge and skill in the art. The scope of enablement only needs to bear a "reasonable correlation" to the scope of the claims. As the Court stated in *In re Goffe*, 542 F.2d 564, 567, 191 USPQ

429, 431 (CCPA 1976), "[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not service the constitutional purpose of promoting progress in the useful arts."

For at least the above reasons, applicants respectfully submit that the §112, first paragraph rejection is without merit and should be withdrawn. Such action is earnestly solicited.

Claims 1, 2, 5, 6, 10, 13, 14 and 17 were rejected under 35 U.S.C. §112, second paragraph, for the reasons given on pages 5-8 of the Office Action. In response thereto, the claims have been amended to eliminate language which modifies a broad recitation with a narrower one. As suggested by the Examiner, the narrower descriptions have been presented in new dependent claims.

In view of the above amendments and remarks, the §112, second paragraph rejection should be withdrawn.

Claims 10 and 16 have been rejected under 35 U.S.C. §102(b) as anticipated by JP 10-330470 for the reasons expressed on pages 8-9 of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

Claim 10 is directed to a multi-stage method which includes a first step of reacting a saturated or unsaturated fatty acid and/or at least one ester of a saturated or unsaturated fatty acid with at least one dicarboxylic acid anhydride wherein the fatty acid contains a secondary hydroxyl group. In a subsequent step, the half ester reaction product from step

one above is reacted with a polyhydroxyl compound. According to claim 16, the first step is performed at temperatures of 150°-200°C. and the subsequent step at 230°-250°C.

The English language Abstract of JP '470 discloses a one-step method where a fatty acid, polybasic acid and polyhydric alcohol apparently are simultaneously reacted to form a fatty acid-modified polyester polyol. Such a one-step reaction leads to different products than the presently claimed multi-stage reaction.

Moreover, the Abstract of JP '470 does not mention fatty acids which contain a secondary hydroxyl group nor the temperature ranges set forth in claim 16.

In view of the above distinctions, JP '470 is not an anticipatory reference. Therefore, the §102(b) rejection should be withdrawn.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If the Examiner has any questions concerning this paper or the application in general, he is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By: George F. Lesmes
George F. Lesmes
Registration No. 19,995

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620